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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,382	11/29/2000	Robert P. Hale	042390.P6770	7418

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EXAMINER

CONNOLLY, MARK A

ART UNIT PAPER NUMBER

2115

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/733,382

Applicant(s)

HALE, ROBERT P.

Examiner

Mark Connolly

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

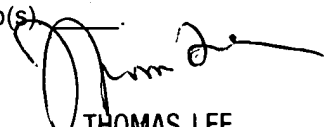
Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
10. ☒ Other: See attached remarks


THOMAS LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

REMARKS

Applicant argues in substance that (1) data comprising a replacement BIOS is not the same as data comprising system configuration settings because a BIOS comprises instructions and data (2) applying the teachings of Gharda et al to Western Digital would require the download of instructions and configuration data to be applied during power-on or reset and thus would necessitate the replacement of the system BIOS every time in order to operate the invention (3) the second signal is applied during power-on or reset by the existing BIOS, not a replacement BIOS as taught by Gharda et al (4) the application of Tate et al to Western Digital will merely result in a method to locate network configuration parameters and download them from the Internet (5) the background section defines configuration signals as "signals that may determine various settings for the operation of the computer system" (6) Tate et al teaches a system where the application of new network configuration signals may not require the system to reboot.

Response to Arguments

In response to argument (1), in addition to the BIOS comprising instructions, the BIOS also comprises system configuration settings. For example, if a user wishes to update the BIOS for their system, the user could download the new BIOS from their motherboard manufacturer. The user would lookup the model number of their motherboard in order to access a new BIOS which is compatible with their system. Because a BIOS is hardware specific, the BIOS at least comprises configuration settings for the system's motherboard. Because the motherboard is part of the system, the motherboard's configuration settings are interpreted as system configuration settings. In addition, it is well known that a BIOS comprises configuration settings for other

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components of the system which are usually defined as “default settings” or something similar which can be accessed with the help of a BIOS utility which allows current system configuration settings to be altered or default settings to be loaded.

In response to argument (2), the claims require that the second signal be “applied to the computing system upon at least one of power-on and reset.” It is argued by the examiner that the system configuration settings from the newly flashed BIOS are applied to the computing system upon at least one of power-on and reset. Because the BIOS remains on the system, there is no need to replace it every time during power-on or reset.

In response to argument (3) that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., “the second signal is applied during power on or reset by the existing BIOS”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to argument (4), the system requires the network configuration to connect to a particular network and since the configuration is required by the system, it is interpreted as system configuration.

In response to argument (5) that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., configuration signals are “signals that may determine various settings for the operation of the computer system”) are not recited in the rejected claim(s). Although the claims are interpreted in light of

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the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to argument (6) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the application of configuration data requiring the system to reboot) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).